

REMARKS

Favorable reconsideration of this application in light of the above amendments and following discussion is respectfully requested.

Claims 1-10 are pending in the present application. By this amendment, Claims 1 and 7 are amended; Claim 11 is added; and no claims are canceled. It is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, Claim 10 was objected under 37 C.F.R. § 1.75(c); Claims 1 and 3-10 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 2,608,472 to Flosdorf in view of In re Japiske; and Claim 2 was rejected under 35 U.S.C. § 103(a) as unpatentable over Flosdorf in view of In re Japiske and SU 1535565 Russian Publication to Aleksandro.

Regarding the objection to Claim 10, Applicants respectfully submit that MPEP § 2173.05(g), referring to functional limitations, states that there “is nothing inherently wrong with defining some part of an invention in functional terms.” Applicants note that Claim 10 recites that the second heater is configured to produce a temperature 5-50 °C lower than a temperature of the first heater, which is a functional limitation as defined by MPEP § 2173.05(g), i.e., “[a] functional limitation is an attempt to define something by what it does, rather than by what it is.” Therefore, Applicants respectfully submit that a functional limitation further limits the claim and that the objection to Claim 10 be withdrawn.

The rejection of Claims 1 and 3-10 under 35 U.S.C. § 103(a) as unpatentable over Flosdorf in view of In re Japiske is respectfully traversed for at least the following reasons.

The claimed recites liquefying a solid material, evaporating the liquefied material by an evaporation roller, and then solidifying it again for purification. According to exemplary embodiments of the present invention, the evaporation and solidification are conducted on the surface of the roller.

In contrast, Flosdorf discloses that a material is directly evaporated (sublimated) by use of stirring vanes (agitator) in a cylinder and then the material is returned to a solid again. As such, the state of the material to be purified and the method thereof are different from those recited in the claimed invention. Additionally, Flosdorf discloses that the evaporation and solidification are carried out by use of stirring vanes within the cylinder. This is different from that of exemplary embodiments of the present invention in which the evaporation and solidification are carried out on the surface of a roller. Finally, in Flosdorf, the solid material is directly sublimated and therefore dust will be formed at the time of evaporation. Accordingly, a filter is used to prevent incorporation of the dust into the purified solid. In contrast, according to the claimed invention, since the solid material is liquefied and then evaporated, the problem associated with the dust does not occur.

With respect to a motivation to combine the reference, it is respectfully submitted that there is no basis in the teachings of either Flosdorf or In re Japiske to support their applied combination. Certainly, the outstanding Office Action fails to cite to any specific teachings within either reference to support the applied combination. Accordingly, it is respectfully submitted that the combination of Flosdorf with In re Japiske is the result of hindsight reconstruction in view of the teachings of the present specification, and is improper.

Initially, Applicants respectfully submit that the outstanding Office Action refers to In re Japiske but fails to discuss which teaching of the case or which statement of law from In re Japiske is applied by the outstanding Office Action. The outstanding Office Action only refers to “a board decision on the rearrangement of parts” without mentioning the underlying facts or the rule established by In re Japiske, which is confusing. Thus, if still applied in the next Office Action, Applicants respectfully request a clarification as to what is relied upon in In re Japiske.

The outstanding Office Action states that Flosdorf discloses in Figure 1 an evaporation roller 10, a precipitation roller 19 and housing 11 and 51. The outstanding Office Action notes that the evaporation roller 10 is diagonally above the precipitation roller 19, which is opposite to the device of Claims 1 and 7, which recite that the precipitation roller is disposed diagonally above the evaporation roller.

In order to cure this deficiency of Flosdorf, the outstanding Office Action states on page 4, second full paragraph, that “there is nothing precluding the teachings of Flosdorf 472 from shifting the location of the rotatable roller handling a precipitation means (19).” Even more, the outstanding Office Action recites in the same paragraph that the “Examiner is unable to reason why Flosdorf 472 is not capable of being modified in a manner as claimed by applicant.”

Applicants respectfully submit that MPEP § 2142, when defining the legal concept of *prima facie* obviousness, requires that “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.”

Again, Applicants respectfully submit that the outstanding Office Action does not provide any suggestion or motivation for modifying Flosdorf as proposed by the outstanding Office Action. That is, by stating that the “Examiner is unable to reason why Flosdorf 472 is not capable for being modified in a manner as claimed by applicant” suggests hindsight. It is noted in this respect that MPEP § 2143 requires that the “teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be found in the prior art**, not in applicant’s disclosure.” (Emphasis added). In the instant case, it appears that the outstanding Office Action does not provide any reasons for changing the positions of

the evaporation roller and the precipitation roller in Flosdorf except for the desire to reproduce the claimed device.

Presumably, the outstanding Office Action relies on In re Japiske for the proposition that rearranging parts in a device is not novel. However, the rearrangement of parts matter is discussed by MPEP § 2144.04 VI. C. In that section, MPEP states with reference to In re Japiske, the claims to a hydraulic power press were held unpatentable “because shifting the position of the starting switch would not have modified the operation of the device.” Therefore, the test of In re Japiske to be applied when using the rearrangement of parts is whether or not the operation of the device is modified. Applicants respectfully submit that the outstanding Office Action did not apply that test to Flosdorf or to the claimed device and therefore, at least for this reason, the outstanding Office Action is improper.

It is noted that applying the above discussed test to Flosdorf, if one of ordinary skill in the art would change the evaporating roller 12 with the precipitation roller 19 as suggested by the outstanding Office Action, the device of Flosdorf will become inoperable because steam is supplied to the cavity 11 to vaporize the substance to be vaporized and the substance to be vaporized is also supplied to the same cavity 11 in which the evaporation roller should be placed and not the precipitation roller 19.

Alternately, if the outstanding Office Action suggests physically changing the position of the precipitation roller 19 in Flosdorf such the precipitation that roller becomes diagonally above the evaporation roller 10, Applicants respectfully submit that the duct 14, filter chamber 15 and all the pipes 32-40 would have to be modified in Flosdorf to accommodate that change, not to mention that the operation principle of the apparatus of Flosdorf would change.

Therefore, Applicants respectfully submit that there is no teaching or motivation to modify the components of the apparatus of Flosdorf and the rearrangement of parts test of In

re Japiske was not properly applied by the outstanding Office Action as required by MPEP § 2144.04 VI. C. Assuming arguendo that the rearrangement of parts test is applied to the claimed device, Applicants respectfully submit that when the precipitation roller is below the evaporation roller, the evaporated substance cannot raise to deposit on the precipitation roller to precipitate, thus changing the operation principle of the claimed device.

Thus, Applicants respectfully submit that independent Claims 1 and 7 and dependent Claims 2-6 and -11 patentably distinguish over Flosdorf either alone or in combination with In re Japikse.

Consequently, for the reasons discussed in detail above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for allowance. Therefore, a Notice of Allowance is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below listed telephone number.

Respectfully submitted,

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